

REMARKS/ARGUMENTS

Reconsideration and allowance of this application are respectfully requested.

Currently, claims 14, 16-21 and 23-35 are pending in this application.

Allowable Subject Matter:

The Decision on Appeal mailed February 4, 2010 reversed the Examiner's decision to reject claims 14, 16-21 and 23-34 under 35 U.S.C. § 103. (See section VIII (1.) of the Decision on Appeal.) Only claims 20, 21 and 23-27 stand rejected in view of the new ground of rejection under 35 U.S.C. § 101.

Applicant thus submits that claims 14, 16-19, 28-32 and 34 are allowable. That is, independent claims 14, 28 and 32 and their respective dependents are allowable.

Claim 33 was also not rejected by the new grounds of rejection issued in the Decision on Appeal. By this Amendment, claim 33 has been rewritten in independent form including the limitations of prior base independent claim 21. Applicant thus submits that claim 33 is thus allowable.

Rejection Under 35 U.S.C. § 101:

The Decision on Appeal instituted the following new rejection: claims 20-21 and 23-27 were rejected under 35 U.S.C. § 101 as allegedly being directed to non-statutory subject matter.

In particular, section VI (pages 8-9) of the Decision on Appeal states the following:

“Independent claims 20 and 27 recite, in relevant part, ‘[a] machine-readable carrier tangibly carrying machine executable instructions and a URL for operating a network circuit using the URL.’

According to Appellants' Specification, machine-readable carriers carrying a URL may either be construed as a digital signal encoded with a URL or a signal carrier carrying a signal. (FF 1.) We find that such transmissions implicate a carrier wave or a signal modulated by a carrier over a transmission medium. Therefore, independent claims 20 and 27 encompass the use of a computer data signal embodied in a carrier wave to transmit information. A computer data signal embodied in a carrier wave is a transitory, propagating signal not within any of the four statutory categories and, therefore, non-statutory. *See In re Nuijten*, 500 F.3d 1346, 1357 (Fed. Cir. 2007).

* * * * *

We find that Appellants' 'URL product' claim implicates a carrier wave or a signal modulated by a carrier over a transmission medium. Therefore, independent [claim] 21 encompasses the use of a computer data signal embodied in a carrier wave to transmit information. A computer data signal embodied in a carrier wave is a transitory, propagating signal not within any of the four statutory categories and, therefore, non-statutory."

By this Amendment, independent claim 20 has been amended to recite "A computer for use in a communications network including a circuit-switched network, the computer including a store programmed with machine executable instructions and a URL" Independent claim 21 has been similarly amended to recite "A computer for use in a communications network including a circuit-switched network, the computer including a store programmed with a Uniform Resource Locator product with a uniform resource locator (URL)" Finally, independent claim 27 was amended to require "A computer for use in a communications network including a circuit-switched network, the computer including a store programmed with machine executable instructions and a Uniform Resource Locator product with a Uniform Resource Locator (URL)...." Accordingly,

independent claims 20-21 and 27 each explicitly and unambiguously requires a computer, and thus explicitly requires a machine -- one of the specifically enumerated categories of statutory subject matter identified in 35 U.S.C. § 101. Claims 20-21 and 27 and their respective dependents are thus “tied” to a machine -- again, one of the specifically enumerated categories of statutory subject matter identified in 35 U.S.C. § 101.

Applicant therefore requests that the rejection of claims 20-21 and 23-27 under 35 U.S.C. § 101 be withdrawn. For purposes of comparison, claim 33 (now rewritten in independent form by incorporating the limitations of former claim 21) was not rejected under 35 U.S.C. § 101 in the Decision on Appeal. Claim 33 requires “A data server for use in a communications network including a circuit-switched network, the data server including a store programmed with a Uniform Resource Locator product with a uniform resource locator (URL)...” By comparison, independent claim 21 (as amended) requires “A computer for use in a communications network including a circuit-switched network, the computer including a store programmed with a Uniform Resource Locator product with a uniform resource locator (URL)” Claims 33 and 21 thus share a common similarity: they both explicitly recite a machine. Namely, claim 33 requires a data server and claim 21 requires a computer. Since both independent claims 33 and 21 explicitly recite a machine, claims 33 (not rejected by the Board) and 21 are both directed to statutory subject matter under 35 U.S.C. § 101. Similar comments apply to independent claims 20 and 27.

New claim:

New claim 35 has been added. This claim is essentially identical to previous

JONES et al.
Application No. 09/831,274
March 24, 2010

(without current amendment) claim 27, but which further requires the limitation “non-transitory.” New claim 27 is statutory under 35 U.S.C. § 101 (see USPTO memo “Subject Matter Eligibility of Computer Readable Media” signed by David J. Kappos on January 26, 2010).

Conclusion:

Applicant believes that this entire application is in condition for allowance and respectfully requests a notice to this effect. If the Examiner has any questions or believes that an interview would further prosecution of this application, the Examiner is invited to telephone the undersigned.

Respectfully submitted,

NIXON & VANDERHIE P.C.

By: _____

Raymond Y. Mah
Reg. No. 41,426

RYM:dmw
901 North Glebe Road, 11th Floor
Arlington, VA 22203-1808
Telephone: (703) 816-4044
Facsimile: (703) 816-4100